UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,444	12/03/2003	Kuldeep Karnawat	MSFT-2556 / 303212.1	7106

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EXAMINER
FERNANDEZ RIVAS, OMAR F

ART UNIT	PAPER NUMBER
2129	

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>03 December 2003</u>.
2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-25</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-25</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on <u>03 December 2003</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/1/2004</u>.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-25 are pending on this application.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

Claims 1-25 are rejected under 35 U.S.C. 101 because the claimed invention is
directed to non-statutory subject matter. The computer system must set forth a practical
application of judicial exception to produce a real-world result. Benson, 409 U.S. at 71-
72, 175 USPQ at 676-77. The invention is ineligible because it has not been limited to a
substantial practical application.

For a claimed invention to be statutory the claimed invention must produce a
useful, concrete, and tangible result. The Courts have found that subject matter that is
not a practical application or use of an idea, a law of nature or a natural phenomenon is
not patentable. See, e.g., *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507
(1874) ("idea of itself is not patentable, but a new device by which it may be made
practically useful is"); *Warmerman*, 33 F.3d at 1360, 31 USPQ2d at 1759.

For a claimed invention to be statutory under 35 U.S.C. 101, the claims must
have the FINAL RESULT (not the steps) produce a useful (specific, substantial, AND
credible), concrete (substantially repeatable/ non-unpredictable), AND tangible (real
world/ non-abstract) result.

If the specification discloses a practical application but the claim is broader than the disclosure such that it does not require the practical application, then the claim must be amended. A claim that recites a computer that solely calculates a mathematical formula is not statutory.

In the present case, claim 1 describes a method to gather information from a user to perform a search in a search mechanism. The claim describes the steps executed by the method to gather the information to perform the search. However, after gathering the information from the user, nothing is being done with the information gathered. It is not applied to a device or presented to a user in a way that would make the use of the method useful and tangible. The information is kept in the search mechanism, which is considered a manipulation of abstract ideas (not tangible). Claims 2-12 further describe the steps executed by the method but fail to provide a useful and tangible result from using the method.

Claims 13-25 describe subject matter similar to that of claims 1-12 and are rejected on the same basis.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 9-16, 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Biebesheimer et al (US Patent Application #09/778,135, referred to as **Biebesheimer**).

Claims 1, 13 and 25

Biebesheimer anticipates a system and a method for gathering context-based user feedback for a search mechanism, where said search mechanism is adapted to perform a search in response to user inputs and where at least one user has access to said search mechanism (**Biebesheimer**: abstract, L1-23; Examiner's Note (EN): a query is a search), said method comprising: monitoring of said search mechanism for user behavior data regarding an interaction of one of said at least one users with said search mechanism to perform a search (**Biebesheimer**: abstract, L17-26; page 1, par 2, L1-7; page 6, pars 49-50; EN: monitoring user interactions is monitoring user behavior data); monitoring said search mechanism for search mechanism response data regarding said search (**Biebesheimer**: page 2, pars 16-18; EN: modifying and generating an output response based on the query is monitoring for search mechanism response data (output response)); determining context data describing said search (**Biebesheimer**: abstract, L1-12; page 3, par 29, L13-26; page 3, par 30, L1-13); and determining user feedback data describing said search (**Biebesheimer**: page 2, par 18, L5-13; page 4, par 41; page 6, par 49-50; EN: user interaction (feedback) describe the query (search)).

Claims 2 and 14

Biebesheimer anticipates said search mechanism is a web browser (**Biebesheimer**: page 3, par 33, L14-17) and where said user behavior data comprises data concerning the firing of one or more events, where each of said events is fired when a corresponding user behavior occurs (**Biebesheimer**: page 3, par 19, L1-15; page 3, par 30; EN: modifying the user interface based on the interactions made by the user (behavior) is firing an event when a user behavior occurs).

Claims 3 and 15

Biebesheimer anticipates said corresponding user behavior is selected from the group comprising: entering a search query; said user navigation to a new page using a hyperlink; said user navigation to a new page using a history list; said user navigation to a new page using an address bar; said user navigation to a new page using a favorites list; user scrolling behavior; user document printing behavior; said user adding a document to said favorites list; said user switching focus to a different application; said user switching focus back from a different application; and said user closing a window (**Biebesheimer**: abstract, L1-12; page 3, par 30; page 8, par 67; Fig. 1; EN: receiving a user query).

Claims 4 and 16

Biebesheimer anticipates said search mechanism is a web browser (**Biebesheimer**: page 3, par 33, L14-17) and where said search mechanism response data regarding said search comprises a results list (**Biebesheimer**: page 2, par 18; page 9, par 73; EN: the response set is a results list).

Claims 9 and 21

Biebesheimer anticipates said context data describing said search comprises

user behavior data (**Biebesheimer**: abstract, L4-12; page 4, par 35, L1-9; page 5, par

41, L7-17; page 12, claim 9; user interaction data is user behavior data).

Claims 10 and 22

Biebesheimer anticipates said user feedback data comprises explicit user

feedback (**Biebesheimer**: page 5, par 41, L7-17; page 6, par 50; page 12, claim 7; EN:

present user interaction data is explicit feedback). .

Claims 11 and 23

Biebesheimer anticipates said user feedback data comprises implicit user

feedback based on said user behavior data (**Biebesheimer**: page 2, par 19, L3-12;

page 12, claims 7 and 12; EN: history of user interaction feedback is implicit user

feedback).

Claim 12

Biebesheimer anticipates a computer-readable medium having computer-

executable instructions to perform the method of claim 1 (**Biebesheimer**: page 13,

claim 20).

Claim 24

Biebesheimer anticipates a method for testing a relevance model, where said

relevance model provides a prediction for user satisfaction with a search performed on

a search mechanism (**Biebesheimer**: abstract, L1-12; page 2, par 16, L3-12; page 3,

par 30; EN: providing results based on the relevance to the user query is predicting data

for user satisfaction), and where said search mechanism is adapted to perform a search

in response to user inputs and where at least one user has access to said search

mechanism (**Biebesheimer**: abstract, L1-12), said method comprising: monitoring of

said search mechanism for user behavior data regarding an interaction of one of said at

least one users with said search mechanism to perform a search (**Biebesheimer**:

abstract, L17-26; page 1, par 2, L1-7; page 6, pars 49-50; EN: monitoring user

interactions is monitoring user behavior data); monitoring said search mechanism for

search mechanism response data regarding said search (**Biebesheimer**: page 2, pars

16-18; EN: modifying and generating an output response based on the query is

monitoring for search mechanism response data (output response)); determining

context data describing said search (**Biebesheimer**: abstract, L1-12; page 3, par 29,

L13-26; page 3, par 30, L1-13); determining user feedback data describing said search

(**Biebesheimer**: page 2, par 18, L5-13; page 4, par 41; page 6, par 49-50; EN: user

interaction (feedback) describe the query (search)); and comparing said user feedback

data with said prediction from said relevance model (**Biebesheimer**: page 3, par 30;

EN: presenting the user with the data that most fit (relevance model) the user's most

important context choices (feedback)) in the current query).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

Claims 5-8 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Biebesheimer as set forth above in view of http://Whatis.techtarget.com (State

Machine; referred to as **Whatis)**.

Claims 5 and 17

Biebesheimer does not teach tracking, using a state machine comprising at least

two states describing progress through said search, which of said states said search is

in.

Whatis teaches tracking, using a state machine comprising at least two states

describing progress through said search, which of said states said search is in (**Whatis**:

pages 1 and 2; EN: a state machine describes the transitions (progress) from one state

to another in a system based on the inputs received and outputs produced. If a state

machine is used to implement a search system, the state machine will describe in which

state the search is in).

It would have been obvious to one of ordinary skill in the arts at the time of the

applicant's invention to modify the teachings of Biebesheimer by using a state machine

to describe the state of the search as taught by Whatis for the purpose of having a

mapping between the state of the search and the inputs received and the outputs

produced by the system.

Claims 6 and 18

Biebesheimer teaches said context data describing said search comprises state

data regarding which of said states were tracked during said search (**Biebesheimer**:

abstract, L4-12; page 3, par 29, L13-24; EN: the inputs given by the user will drive the system to the next state).

Claims 7 and 19

Biebesheimer teaches least one transition between said states in said state machines is at least partially dependent on explicit user feedback (**Biebesheimer**: abstract, L4-12; page 3, par 30, L1-17; page 12, column 1, L3-8, page 12, claim 7; present user interactions or queries are explicit user feedback that will define a transition in the system).

Claims 8 and 20

Biebesheimer anticipates said context data describing said search comprises said explicit user feedback (**Biebesheimer**: abstract, L4-12; page 5, par 41, L7-17; page 12, column 1, L3-8; EN: the context is associated with the query (explicit feedback)).

Conclusion

5.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Biebesheimer US Patent #6,853,998

Delgado et al US Patent #6,801,902

6.   Claims 1-25 are rejected.

Correspondence Information

7.   Any inquires concerning this communication or earlier communications from the

examiner should be directed to Omar F. Fernández Rivas, who may be reached

Monday through Friday, between 8:00 a.m. and 5:00 p.m. EST. or via telephone at

(571) 272-2589 or email omar.fernandezrivas@uspto.gov.

If you need to send an Official facsimile transmission, please send it to (571) 273-8300.
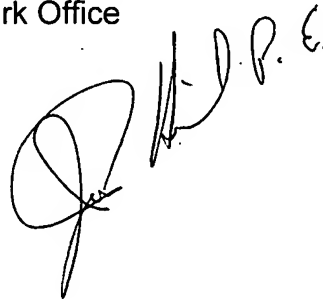
     If attempts to reach the examiner are unsuccessful the Examiner's Supervisor,

David Vincent, may be reached at (571) 272-3080.

     Hand-delivered responses should be delivered to the Receptionist @ (Customer

Service Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located

on the first floor of the south side of the Randolph Building.

Omar F. Fernández Rivas
Patent Examiner
Artificial Intelligence Art Unit 2129
United States Department of Commerce
Patent & Trademark Office

Wednesday, May 03, 2006

OFR